

RI029180-2

REMARKS

Claims 1-17 and 36-42 are pending in the present Application. Claims 1, 9 -- 11, and 42 have been amended, Claims 8 and 36 have been cancelled, and Claims 43 -- 53 have been added, leaving Claims 1 -- 7, 9 -- 17, and 37 -- 53 for consideration upon entering the present Preliminary RCE Amendment. Support for these amendments and new claims can be found in the application as originally filed, for example, in Claim 8, as well as in Paragraph [0019]. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Applicants' Attorney would first like to thank the Examiner for his time on July 12, 2005 when the Advisory Action was discussed. In the telephone conversation, Applicants' Attorney explained that Applicants do not agree that Mishina et al. anticipate the present claims as set forth in the Advisory Action, however, due to the expense and time of performing the tests to prove Applicants position, Applicants suggested amending the claims such that the solvent consists of the materials listed in Claim 8. The Examiner agreed that he believed such an amendment would overcome Mishida et al., but that he needed to review the case and possibly perform another search. Again, Applicants' Attorney appreciates the Examiner's time, especially his willingness to talk after the issuance of the Advisory Action. If there are any issues with respect to the claims submitted in this amendment, the Examiner is invited to call the undersigned to discuss those issues.

Applicants note that they maintain their position regarding the novelty and non-obviousness of the present application as set forth in the response to the Final Rejection.

Claims 1, 7-11, 14-17, and 38 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 5,916,632 to Mishina et al., while Claims 2-6, 12-13, 37, and 42 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Mishina et al. Applicants respectfully traverse these rejections.

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987).

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Mishina et al. require the solvent to comprise propylene glycol derivative and state the criticality of that material: "[t]he obtained coating film had fine irregularities... on the surface, and it was impossible to obtain a smooth film..." without the propylene glycol derivative. (Col. 6, lines 10 – 12, 23 -- 25, 36 – 39, and 46 -- 48; emphasis added)

The present application claims the formation of a smooth coating (e.g., coating having less than or equal to 10 asperities over the entire surface of the coated substrate), without the use of a propylene glycol derivative

Since Mishina et al. fail to teach several elements of the present claims, such as the properties of the solvent employed in the present claims, they fail to anticipate the present claims. Reconsideration and withdrawal of these rejections are respectfully requested.

Claim 39 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Mishina et al. in view of U.S. Patent No. 6,715,200 to Feist et al. and further in view of U.S. Patent No. 5,055,631 to Sartori et al. Claim 40 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Mishina et al. in view of Feist et al. and further in view of Japanese Patent Abstract 1991-017337 to Kageyama et al. Claim 41 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Mishina et al. in view of Feist et al. and further in view of Sawaoka et al. and U.S. Patent No. 4,842,740 to Chung et al. Applicants respectfully traverse these rejections.

Applicants first note that the claims are nonobvious as described in detail above with respect to the anticipation and obvious rejections over Mishina et al.

It is further noted that this rejection is improper since Feist et al. is not a proper reference. 35 U.S.C. § 103(c) states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (c), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The subject matter of Feist et al. and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same person, namely, General Electric Company. Additionally, Feist et al., only qualifies as prior art under 35 U.S.C. § 102(e) since it

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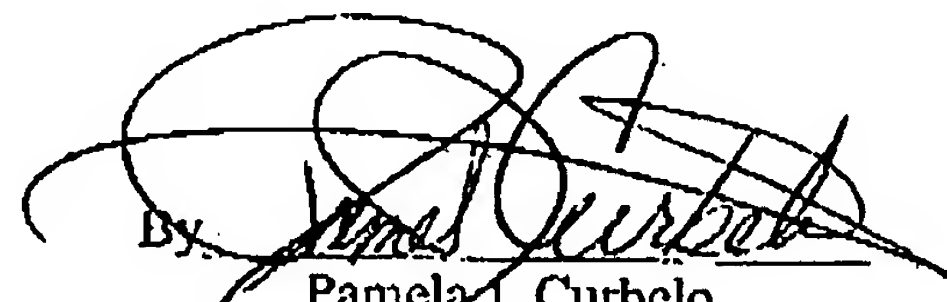
published February 21, 2002, and the present application has a filing date of April 18, 2002, and a priority date of April 19, 2001. Hence, all of the rejections that rely upon Feist et al. are not proper rejections. Reconsideration and withdrawal of these rejections are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Final Rejection and Advisory Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the rejections and allowance of the case are respectfully requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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